

### **REMARKS**

Claims 1, 4, 7-9, 16-17, 43-44, 46, and 48-63 are pending. Claims 1, 43, and 54 have been amended.

#### **Telephone Interview**

Applicants note with appreciation the telephone interview dated June 9, 2010, between Examiner Ross Williams and Applicants' representative, attorney Sorinel Cimpoes. As noted in more detail below, the Examiner has agreed that the pending claims overcome the art of record and should be in condition for allowance.

#### **§ 102 and § 103 Rejections**

Claims 1, 4, 8-9, 16-17, 43-44, 46, and 48-51 have been rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent Application Publication No. 2005/0130731 A1 to Englman *et al.* ("Englman"). Claims 7 and 54-63 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Englman in view of U.S. Patent Application Publication No. 2004/0053666 A1 to Vancura. Claims 52-53 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Englman in view of U.S. Patent No. 6,929,264 to Huard.

During the interview, Applicants' representative explained in reference to claim 1 that Englman fails to disclose the claimed progressive award, which includes a plurality of free plays that increases based on the wager received at the gaming terminal and on other wager inputs received from other gaming terminals. To further clarify this aspect of the claimed progressive award and in accordance with the Examiner's suggestion, the term "incrementally" has been

added to claim 1. The other independent claims have also been amended to further clarify that the progressive award increases incrementally based on wager inputs received at a plurality of gaming terminals.

As such, at least for the above stated reasons, Englman fails to disclose all the claim elements of the pending claims. Thus, Englman can only be used (at most) in a § 103 obviousness analysis. However, for the reasons presented below in more detail, Englman is disqualified as prior art under 35 U.S.C. § 103(c).

The Examiner agreed that the pending claims are patentable over the art of record and should tentatively be in condition for allowance at least for the above stated applicable reasons.

#### **Disqualification of Englman Under 35 U.S.C. § 103(c)**

All the claims have been rejected based on Englman (alone or in combination with another reference). However, for subject matter that qualifies as prior art under 35 U.S.C. §§ 102(e), (f), or (g), 35 U.S.C. § 103(c) prevents such subject matter from being used in a § 103 obviousness analysis, if “the subject matter and the claimed invention, were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.” Manual of Patent Examining Procedure, Rev. 6, Sept. 2007, § 706.02(l)(1), p. 700-54, *quoting* 35 U.S.C. § 103(c)(1).

##### **A. Englman is prior art under 35 U.S.C. § 102(e)**

The present application was filed as a national phase application based on an International Patent Application filed on March 18, 2005. Englman was filed on December 10, 2003 (prior to the filing of the present application) and was published on June 16, 2005 (after the filing of the present application). Thus, Englman qualifies as prior art under 35 U.S.C. § 102(e).

B. Common Ownership

**THE PRESENT APPLICATION AND ENGLMAN WERE, AT THE TIME THE INVENTION OF THE PRESENT APPLICATION WAS MADE, BOTH SUBJECT TO AN OBLIGATION OF ASSIGNMENT TO A COMMON ASSIGNEE, WMS GAMING INC.**

In addition to the above statement regarding common ownership, the Applicant notes that an assignment for the present application was recorded at Reel/Frame No. 018734/0191, and an assignment for Englman was recorded at Reel/Frame No. 014799/0015. These two recorded assignments convey the entire rights in the present application and in Englman to the same entity: WMS Gaming Inc.

Therefore, 35 U.S.C § 103(c) applies and a rejection under § 103 cannot be made using Englman. Because Englman fails to disclose at least one element of the pending claims, all the pending claims would – at most – be rejected under § 103 (including the claims currently rejected under § 102). Accordingly, as agreed during the telephone interview, the Applicant respectfully requests that the rejections against all the pending claims be withdrawn.

**Conclusion**

It is the Applicants' belief that all of the claims are now in condition for allowance and action towards that effect is respectfully requested. If there are any matters which may be resolved or clarified through a telephone interview, the Examiner is requested to contact the undersigned attorney at the number indicated.

It is believed that no fees are due; however, should any fees be required (except for payment of the issue fee), the Commissioner is authorized to deduct the fees from Nixon Peabody LLP Deposit Account No. 50-4181, Order No. 247079-000254USPX.

Respectfully submitted,

Date: June 9, 2010

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